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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,822

11/24/2003

Masaki Shimada

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27799 7590 12/18/2006  
COHEN, PONTANI, LIEBERMAN & PAVANE  
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EXAMINER

FLEURANTIN, JEAN B

ART UNIT

PAPER NUMBER

2162

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/18/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/723,822

Applicant(s)

SHIMADA ET AL.

Examiner

JEAN B. FLEURANTIN

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/15/4.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This is in response to Applicant(s) arguments filed on 11/24/03.

The following is the current status of claims:

Claims 1-11 are resented for examination.

Communication (status letter) filed on 12/16/05 is acknowledged.

*Information Disclosure Statement*

The information disclosure statement (IDS) submitted on 03/15/04. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

*Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

*Drawings*

The Drawings submitted on 11/24/03 are acknowledged.

*Objections / Specification*

The abstract is objected to because of "to / from" and "transmit / receive". Appropriate correction is required.

*Claim Objections*

Claim 1 is objected to because of "insertion / ejection", "in / from" and transmitting / receiving". The Examiner suggests the Applicants to amend the claim in order to be more specific.

Claim 2 is objected to because of "insertion / ejection" and transmitting / receiving". The Examiner suggests the Applicants to amend the claim in order to be more specific:

Claim 3 is objected to because of "insertion / ejection". The Examiner suggests the Applicants to amend the claim in order to be more specific.

Claim 4 is objected to because of "insertion / ejection", "in / from" and transmitted / received". The Examiner suggests the Applicants to amend the claim in order to be more specific.

Claim 8 is objected to because of "and / or". The Examiner suggests the Applicants to amend the claim in order to be more specific.

Claim 11 is objected to because of "transmission / reception". The Examiner suggests the Applicants to amend the claim in order to be more specific.

Claims 5 and 6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims 1 or 4, . See MPEP § 608.01(n). Accordingly, the claims 5 and 6 have not been further treated on the merits.

Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims 1 to 7. See MPEP § 608.01(n). Accordingly, the claim 6 has not been further treated on the merits.

Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims 1 to 8. See MPEP § 608.01(n). Accordingly, the claim 9 has not been further treated on the merits.

Claim 10 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims 1 to 9. See MPEP § 608.01(n). Accordingly, the claim 10 has not been further treated on the merits.

Claim 11 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims 2 and 3 and 5 to 10. See MPEP § 608.01(n). Accordingly, the claim 10 has not been further treated on the merits.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent Application No. 10/734,489. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to the patent Application No. 10/723,822 claims 1 and 2 to interchangeably or delete "and an operating member which starts operation of reading out digital information from the first recording medium and writing the information in the second recording medium, wherein said first and second insertion/ejection portions are connected to be capable of transmitting/receiving digital information, and said control means searches for digital information recorded on the first recording medium inserted in said first insertion/ejection portion in accordance with operation of said operating member, buffers date data of a file, of the found files, which is set at a predetermined rank, creates a new directory in the second recording medium inserted in said second insertion/ejection portion, writes the buffered date data as a creation date of the directory, and writes all the digital information recorded on the first recording medium into the newly created directory" in order to provide an information processing apparatus which has the versatility of allowing connection to an external device and can easily transfer digital information from one recording medium to another recording medium; see patent Application No. 10/723,822.

Claim 1 of U.S. patent Application No. 10/734,489 contain(s) every element of claim 1 of instant application serial No. 10/723,822 and thus anticipate the claim 1 of the instant application. Claim 1 of the instant application therefore are not patentably distinct from the earlier patent application claim 1 and as such as are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

**Instant application 10/723,822**

An information processing apparatus comprising:

a first insertion/ejection portion in/from which a first recording medium can be inserted/ejected and which can at least read out digital information from the inserted first recording medium;

a second insertion/ejection portion in/from which a second recording medium can be inserted/ejected and which can read out and write digital information from and in the inserted second recording medium; control means;

and an operating member which starts operation of reading out digital information from the first recording medium and writing the information in the second recording medium, wherein said first and second insertion/ejection portions are connected to be capable of transmitting/receiving digital information, and said control means searches for digital information recorded on the first recording medium inserted in said first insertion/ejection portion in accordance with operation of said operating member, buffers date data of a file, of the found files, which is set at a predetermined rank, creates a new directory in the second recording medium inserted in said second insertion/ejection portion, writes the buffered date data as a creation date of the directory, and writes all the digital information recorded on the first recording medium into the newly created directory.

**10/734,489**

An information processing apparatus comprising:

a first insertion/removal portion capable of inserting/removing a first recording medium and at least reading out electronic information from the inserted first recording medium, the first recording medium being an optical information recording medium comprising a memory card;

a second insertion/removal portion capable of inserting/removing a second recording medium and reading out, electronic information from and writing electronic information in the inserted second recording medium, and the second recording medium being selected from the group consisting of a magneto-optical recording medium, a hard disk, and an optical information recording medium different from the first recording medium;

an operating member which is connected to the first and second insertion/removal portions so as to be able to exchange electronic information and starts an operation of reading out electronic information recorded on the first recording medium and writing the electronic information in the second recording medium; control means for controlling exchange of electronic information in the information processing apparatus; and expression means for expressing an operation state of the information processing apparatus, wherein when a state in which a recording medium is inserted into at least one of the first and second insertion/removal portions and electronic information can be read out or written is detected, said expression means performs an expression operation of the state.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus)." ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

"Claims 1 and 4 are generic to the species of invention covered by claims 1 and 2 of U.S. Patent Application No. 10/734,489. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that earlier species disclosure in the prior art defeats any generic claim). This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 1, 14 and 21 were properly rejected under the doctrine of obviousness-type double patenting." (In re Goodman (CAFC) 29 USPQ2d 2010 (12/3/1993).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 14-15 and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,588,667 issued to Nakano et al., ("Nakano").

The applied reference has a common Konica with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As per claim 1, Nakano discloses "an information processing apparatus comprising: a first insertion/ejection portion in/from which a first recording medium can be inserted/ejected" (i.e., recording medium inserted or pulled out from the reading apparatus; see col. 4, lines 23-25) and "which can at least read out digital information from the inserted first recording medium" (i.e., data recorded into the recording medium; see col. 4, lines 32-36 and Fig. 1);

"a second insertion/ejection portion in/from which a second recording medium can be inserted/ejected and which can read out and write digital information from and in the inserted second recording medium; control means" (i.e., reading data apparatus, computer and external; see col. 4, lines 35-45 and Fig. 1); and

"an operating member which starts operation of reading out digital information from the first recording medium and writing the information in the second recording medium, wherein said first and

second insertion/ejection portions are connected to be capable of transmitting/receiving digital information" (i.e., limiting information is transmitted; see col. 2, lines 33-45 and 4, 65 to col. 5, line 10),

and "said control means searches for digital information recorded on the first recording medium inserted in said first insertion/ejection portion in accordance with operation of said operating member, buffers date data of a file, of the found files, which is set at a predetermined rank, creates a new directory in the second recording medium inserted in said second insertion/ejection portion" (i.e., directory information represents the name of a predetermined directory indicating a record in which the data information of a predetermined format is recorded in the recording medium by the digital still camera; see col. 5, lines 16-20), "writes the buffered date data as a creation date of the directory, and writes all the digital information recorded on the first recording medium into the newly created directory" (i.e., writing in new data information in a region of the recording medium; col. 3, lines 44-46).

As per claim 2, in addition to claim 1, Nakano further discloses "said connecting portion are connected such that digital information can be transmitted/received from one of said portions to another portion, and said control means permits transmission/reception of digital information, through said connecting portion, between the external device and the first recording medium inserted in said first insertion/ejection portion and/or the second recording medium inserted in said second insertion/ejection portion when detecting that the external device is connected through said connecting portion, and inhibits transmission/reception of digital information through said connecting portion when not detecting that the external device is connected through said connecting portion" (i.e., limiting information is transmitted as an external apparatus; see col. 2, lines 33-34 and Fig. 1).

As per claim 3, in addition to claim 1, Nakano further discloses "when detecting that the external device is connected through said connecting portion, said control means reads out digital information from the first recording medium inserted in said first insertion/ejection portion and inhibiting a direct write in the second recording medium inserted in said second insertion/ejection portion even if said operating portion is operated" (i.e., recording medium connecting to terminals are used as terminals, memory card; col. 4, lines 38-45).

As per claim 4, in addition to claim 1, Nakano further discloses a connecting portion which can be connected to an external device" (i.e., recording medium connecting to terminals are used as terminals, memory card; col. 4, lines 38-45 and Fig. 2, item 310).

As per claims 5-11, the limitations of claims 5-11 are similar to claims 1-4, therefore, the limitations of claims 5-11 are rejected in the analysis of claims 1-4, and these claims are rejected on that basis.

*Prior Art*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Otsuka et al., U.S. Patent No. 5,454,096 relates to a storage management system for a memory card.

**CONTACT INFORMATION**

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 - 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 - 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jean Bolte Fleurantin

Patent Examiner

Technology Center 2100

December 06, 2006